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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,399

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Ryouichi Takayama

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WENDEROTH, LIND & PONACK L.L.P.

2033 K. STREET, NW

SUITE 800

WASHINGTON, DC 20006

EXAMINER

SUMMONS, BARBARA

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,399	Applicant(s) TAKAYAMA ET AL.	
	Examiner BARBARA SUMMONS	Art Unit 2817	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005 (pre-amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 30-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Sub-specification approved</u> . |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.
2. Additionally, it should be noted that the definition of L1 changes between some of the independent claims and in the drawings of the different species of the invention, and some of the claims are not clear as to the difference between L1. For instance, the species of the invention as shown in Fig. 1B (and as defined e.g. in claim 1, lines 9-10) has L1 being measured at the bottom of the convex portion where it meets the concave portion, while L1 as shown in the various species of e.g. Figs. 26-28 (and as defined e.g. in claim 43, lines 9-10) is measured only on the “top part” of the convex portion. Therefore, claim 42 is not clear since $L1+L2 < L$, which indicates that L1 must be measured on the “top part” of the convex portion as shown in Figs. 26-28, but claim 41 (see lines 9-10) fails to define L1 in this manner. Therefore, below the Examiner is giving only a “best guess” as to the claims corresponding to the following species. Note also that claims 52-57, although not generic to all species, appear to be common to multiple (i.e. two) species.

The species are as follows:

Species I: an electronic part with $t2 \leq h$, $L1+L2=L$, $L1 \leq p1$ and $L2 \geq p2$ as shown in Fig. 1B.

Species II: an electronic part with $h \leq t_2$, $L_1 + L_2 = L$, $L_1 \leq p_1$ and $L_2 \geq p_2$ as shown in Fig. 9.

Species III: an electronic part with a protective film that has a flat top surface (not shown in the figures) [see claims 39 and 40].

Species IV: an electronic part with $h \leq t_2$, $L_1 > p_1$, $L_2 < p_2$ and $L_1 + L_2 < L$ as shown in Figs. 26 and 27.

Species V: an electronic part with $h \leq t_2$, $L_1 \leq p_1$, $L_2 < p_2$ and $L_1 + L_2 < L$ as shown in Fig. 28.

Species VI: an electronic part with $0 < t_2 < h$, $L_1 > p_1$ and $L_1 + L_2 < L$ as shown in Fig. 29.

Species VII: an electronic part with $0 < t_2 < h$, $L_1 \leq p_1$, $L_2 < p_2$ and $L_1 + L_2 < L$ as shown in Fig. 31.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

3. The claims are deemed to correspond to the species listed above in the following manner:

Species I: claims 30, 31, 34-38 and 58

Species II: claims 32 and 33

Species III: claims 39 and 40

Species IV: claims 41, 42, 44, 49-53 and 55-57

Species V: claims 43 and 54

Species VI: claims 45, 46, 48, 52, 53 and 55-57 (note that claim 46 directly contradicts claim 45 regarding the relationship of L1 to p1)

Species VII: claims 47 and 54

The following claim(s) are generic: None.

4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The special technical features required for some of the species of the invention, besides being not required in other species, are often also directly contradicted in other species of the invention. For

example, while a special technical feature of $t_2 \leq h$ (or $<$) is required of Species I, VI and VII, exactly the opposite special technical feature of $h \leq t_2$ is required of Species II, IV and V. Similarly, see the opposite special technical features $L_1 > p_1$ required by Species IV and VI, versus $L_1 \leq p_1$ required by Species I, II, V and VII. Also, some Species require a special technical feature of $L_1 + L_2 = L$ while others require $L_1 + L_2 < L$. Therefore, there is no special technical feature common to all the species so as to relate them to a single general inventive concept.

5. A telephone call was made to Mr. Jeffrey R. Filipek (Reg. No. 41,471) on April 23, 2008 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA SUMMONS whose telephone number is (571)272-1771. The examiner can normally be reached on M-Th, M-Fr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pascal can be reached on (571) 271-1769. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bs
April 23, 2008

/Barbara Summons/
Primary Examiner, Art Unit 2817